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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,706	08/05/2003	Jerrold V. Hauck	APPL-P2834DVB	8329

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EXAMINER	
JUNG, MIN	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/635,706	HAUCK ET AL.	
	Examiner	Art Unit	
	Min Jung	2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 28-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not describe "a first substantially asynchronous serialized protocol" and " a second substantially isochronous serialized protocol". The specification teaches two different protocols, but the terminologies used in the claims are not used in the specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 3, 8-15, 17-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2, 3, 17, 18, and 19, it is not clear what is the subject of the functions "determine", "communicate", and "performing the acts of".

In claim 4, line 3, "some where" should be "somewhere".

Further, in claims 18 and 19, line 2, " the device" lacks antecedent basis; it may be changed to " a computing device".

In claim 24, "said device adapted to determine and communicate----" is unclear in that the phrase "adapted to" make the functions of "determine" and "communicate" optional, and therefore, the metes and bounds of the claim is not clearly defined.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2, 3, and 8-15 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 2, and 8-11, "a computer readable medium" recited seems to include not only the computer readable storage medium, but also transmission mediums from interpreting the description at page 14, paragraphs [0056] and [0057]. To make the claim statutory, it is recommended to recite the preamble as "a computer readable storage medium containing computer executable instructions".

Further regarding claim 3 and 12-15, it is not clear what is being claimed; it cannot be determined whether this claim satisfies 101 requirements. "a device" needs to be clarified to recite language acceptable to embody computer executable instructions, such as "a computer readable storage medium containing computer executable instructions----".

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,891,848. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are directed to a method of determining the presence of hybrid bus by examining the received self-ID packet by a node for the absence of a speed code, whereas the present claims are directed to apparatus and method of transmitting a self-ID packet with or without a speed code depending on the determination whether a node has a connection to a legacy link layer, and in the later claims, having further limitation of the presence of lack thereof of the speed designation

to indicate the absence or presence of a hybrid bus. It is clear from this that the same patentable idea is recited from two different perspectives by the patented claims and by the present claims. Therefore, although the claims are not identical, they are not patentably distinct.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone et al., 6,519,657 (Stone).

Stone discloses a method and device for identifying an active 1394a node attached to a 1394b network.

Specifically regarding the claims, Stone teaches 1394b network with 1394a nodes attached to it in addition to 1394b nodes. See Abstract. Stone further teaches determining whether the node has a connection to a Legacy link layer (border node accepts signal "you are my parent" from any 1394a connection, indicating that the node has a connection to a legacy link layer, see col. 6, lines 12-13, also see step 960 in Fig. 7); if the node determines that it has a connection to a Legacy link layer, then transmitting a self-ID packet with a Speed Code (the self-ID packets contain information regarding the speed capabilities of the attached nodes, See Fig. 7, steps 960-985, col.

8, lines 31-67). What Stone fails to specifically teach is the transmission of self-ID packet without a speed code if the node has a connection to a legacy link layer. Stone seems to teach that all self-ID packets contain information regarding the speed capabilities of the attached nodes (although it can be interpreted that the information regarding the speed capabilities in Stone's teaching may be just an indication that a legacy node is connected.). See col. 8, lines 62-67. In the present specification, however, applicant suggests that it is well known by those of ordinary skill in the art that the S100 Alpha format packet contains no speed code, and thus no speed code is repeated into the Beta cloud (page 18, [0073]). Since such is already practiced in the technology, it would have been obvious for one of ordinary skill in the art at the time of the invention to implement the Stone's teaching by not specifically including the speed information when the node has a connection to a legacy link layer as clearly taught in the prior art.

Response to Arguments

10. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 571-272-3127. The examiner can normally be reached on Monday through Friday 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJ
December 8, 2006

Min Jung
Primary Examiner